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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY Docket NO.	CONFIRMATION NO.
10/079,496	02/22/2002	Shigeru Hosoe	02860.0706	9336

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Finnegan, Henderson, Farabow,
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1300 I Street, N.W.
Washington, DC 20005-3315

EXAMINER

HECKENBERG JR, DONALD H

ART UNIT PAPER NUMBER

1722

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/079,496

Applicant(s)

HOSOE, SHIGERU

Examiner

Donald Heckenberg

Art Unit

1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 4-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☒ Claim(s) 2-3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____.

1. Applicant's election of Group I (claims 1-3) in response to the previous Office Action is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 4-7 are withdrawn from further consideration pursuant to 37 CFR 1.142(b).

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Pub. No. 10-217257 (hereinafter "JP '257"; reference below will be made to the machine translation attached to the reference) in view of Inoue et al. (U.S. Pat. No. 6,521,058).

JP '257 discloses a molding die comprising a die base body formed by shaping an amorphous alloy having a super-cooled liquid phase (see translation ¶ 5). JP '257 further discloses $Zr_{55}Cu_{30}Al_{10}Ni_5$ as an amorphous alloy which can be used (see translation ¶ 22). JP '257 does not disclose the composition of the amorphous alloy to contain palladium.

Inoue discloses different high strength, high toughness amorphous alloy. Inoue notes that the alloy compositions can contain palladium to strengthen the composition (see cl. 3, ll. 3-8). Inoue specifically points to the superior characteristics of compositions including palladium as opposed to $Zr_{55}Cu_{30}Al_{10}Ni_5$ (table 1).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the apparatus of JP '257 as such to have included palladium in the composition of the alloy because this would increase the strength of the alloy as suggested by Inoue.

Note, the Inoue reference was filed internationally on October 25, 1999, thus the changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply. Therefore, the prior art date of Inoue is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)). Under the old 35 U.S.C. 102(e), the prior art date would be the date Inoue entered into national stage- which was June 29, 2000. Accordingly, Inoue qualifies as prior art under 35 U.S.C. 102(e), and thus applicable under 35 U.S.C. 103 as used above.

5. Claims 2-3 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to teach or suggest a molding die for molding an optical element with the die made from a composition having the features recited in claims 2 or 3.

The closest art disclosed by the combination of JP '257 and Inoue is described above. Inoue, while teaching amorphous alloys containing palladium specifically discloses the aluminum atomic percent (and thus, mol percent) should be between 5 and 10 percent (cl. 2, ll. 30-41). Further, Inoue does not suggest the use of 30 to 50 mol percent Aluminum in the composition.

7. The following references not relied upon are deemed pertinent to the instant application:

Japanese Pub. No. 63-262213 discloses the use amorphous alloys in optical molding dies (see translated abstract).

Monji et al. (U.S. Pat. No. 4,721,518) discloses glass press molds which include amorphous alloys.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (703) 308-6371. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be

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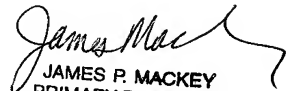
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reached at (703) 308-0457. The official fax phone number for the organization where this application or proceeding is assigned is (703) 972-9306. The unofficial fax phone number is (703) 305-3602.



Donald Heckenberg
October 21, 2003



JAMES P. MACKEY
PRIMARY EXAMINER
10/27/03